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OFFICE OF PETITIONS

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In re Patent No. 7,529,792 :
Josef Dietl : LETTER REGARDING
Issue Date: May 5, 2009 : PATENT TERM ADJUSTMENT
Application No. 10/698,059 : AND NOTICE OF INTENT
Filed: October 29, 2003 : TO ISSUE CERTIFICATE
Attorney Docket No. 24307-0010001 : OF CORRECTION
/2002P10023 :

This is in response to the "LETTER REGARDING PATENT TERM ADJUSTMENT" filed March 26, 2009. Pursuant to patentees' duty of good faith and candor to the Office, patentee requests that the determination of patent term adjustment under 35 U.S.C 154(b) be reviewed for accuracy.

The request for review of determination of the patent term adjustment is **GRANTED**.

The patent term adjustment indicated in the patent is to be corrected by issuance of a certificate of correction showing a revised Patent Term Adjustment of one thousand seventy-one (1071) days.

Patentee is given **THIRTY (30) DAYS or ONE MONTH, whichever is longer**, from the mail date of this decision to respond to this decision. No extensions of time will be granted under 37 CFR 1.136.

On January 6, 2006, a Determination of Patent Term Adjustment under 35 U.S.C. 154(b) was mailed indicating that the patent term adjustment to date was 1,168 days (1,168 days of Office delay - 0 days of applicant delay). On March 26, 2009, patentee submitted the instant comment. Patentee discloses that he believes that the patent term adjustment indicated in the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) mailed January 6, 2009, is incorrect and should be recalculated. Specifically, patentee states that:

Applicants filed an Information Disclosure Statement on August 1, 2008...The Information Disclosure Statement was filed after the response to the non-final Office action. Therefore, Applicants should have been accorded a delay of 56 days for a supplemental response. According to our calculations, the correct PTA should be 1112.

Excerpt from Letter Regarding Patent Term Adjustment filed March 26, 2009, page 1

On May 5, 2009, the above-identified application matured into US Patent No. 7,529,792 with a revised patent term adjustment of 1,127 days. A review of the record reveals that a period of reduction of 41 days was entered pursuant to 37 CFR 1.704(c)(10) for the filing of a Supplemental Combined Declaration and Power of Attorney on April 15, 2009, after the mailing of the Notice of Allowance. Accordingly, at issuance, the initial patent term determination of 1,168 days was reduced by 41 days of applicant delay under 37 CFR 1.704(c)(10) for a revised patent term adjustment of 1,127 days.

Further review of the application history reveals that an Information Disclosure Statement was filed on August 1, 2008, 56 days after a response to a non-final Office action was filed on June 6, 2008. 37 CFR 1.704(c)(8) provides that:

(c) Circumstances that constitute a failure of the applicant to engage in reasonable efforts to conclude processing or examination of an application also include the following circumstances, which will result in the following reduction of the period of adjustment set forth in § 1.703 to the extent that the periods are not overlapping:

(8) Submission of a supplemental reply or other paper, other than a supplemental reply or other paper expressly requested by the examiner, after a reply has been filed, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date the initial reply was filed and ending on the date the supplemental reply or other such paper was filed.

37 CFR 1.704(d) provides that:

(d) A paper containing only an information disclosure statement in compliance with §§ 1.97 and 1.98 will not be considered a failure to engage in reasonable

efforts to conclude prosecution (processing or examination) of the application under paragraphs (c)(6), (c)(8), (c)(9), or (c)(10) of this section if it is accompanied by a statement that each item of information contained in the information disclosure statement was first cited in any communication from a foreign patent office in a counterpart application and that this communication was not received by any individual designated in § 1.56(c) more than thirty days prior to the filing of the information disclosure statement. This thirty-day period is not extendable.

It is undisputed that the Information Disclosure Statement filed August 1, 2008, was filed 56 days after the response to the non-final Office action was filed on June 6, 2008. The record does not support a conclusion that the Examiner expressly requested the filing of the IDS. Further review of the Information Disclosure Statement filed August 1, 2008, reveals that it did not include the proper statement under 1.704(d). Accordingly, pursuant to 37 CFR 1.704(c)(8), a period of reduction of fifty-six (56) days will be entered.

In view thereof, the patent should have issued with a revised Patent Term Adjustment of one thousand seventy-one (1,071) days, (1,168 days of Office delay - 97 days of applicant delay).

As this letter was submitted as an advisement to the Office of an error in the calculation of the Patent Term Adjustment, the Office will not assess the \$200.00 application fee under 37 1.18(e). The Office thanks patentee for his good faith and candor in bringing this to the attention of the Office.

This application is being forwarded to the Certificates of Correction Branch for issuance of a certificate of correction in order to rectify this error. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended, or adjusted, by one thousand seventy-one (1,071) days.

Telephone inquiries regarding this specific matter should be directed to Kenya A. McLaughlin, Petitions Attorney, at (571) 272-3222.

Christina Tartera Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

DRAFT COPY

UNITED STATES PATENT AND TRADEMARK OFFICE

CERTIFICATE OF CORRECTION

PATENT : 7,529,792 B2

DATED : May 5, 2009

INVENTOR(S) : Josef Dietl

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

On the cover page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by (1127) days

Delete the phrase "by 1127 days" and insert – by 1071 days--